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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/663,618	06/14/98	GRAY	2000-000001

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EXAMINER
PROUTY, RART UNIT
1002 PAPER NUMBER

DATE MAILED: 08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/663,618

Applicant(s)

Gray

Examiner

Rebecca Prouty

Art Unit

1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on May 29, 2001

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-18 and 32 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☒ Claim(s) 1-12 is/are allowed.

6) ☒ Claim(s) 13-18 and 32 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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Claims 19-31 have been canceled. Claims 1-18 and 32 are still at issue and are present for examination.

Applicants' arguments filed on 5-29-01, paper No. 24, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claims 13-18 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 (upon which claims 14-18 depend and 32 are indefinite in the recitation of "stringent conditions" as the specification does not define what conditions constitute "stringent". While page 4 of the specification describes some conditions which are intended to be stringent, there is nothing to suggest that other conditions would not also be included within the scope of this term and in the art what is considered stringent varies widely depending on the individual situation as well as the person making the determination. As such it is unclear how homologous to the sequence of a gene encoding SEQ ID NO:2, a sequence must be to be included within the scope of these claims.

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Claim 32 is indefinite in the recitation of "immunogenic fragment" as the scope of this term is unclear. Is this claim limited to fragments of SEQ ID NO:2 which will induce an antibody which specifically binds to SEQ ID NO:2 under some conditions?, to fragments which will induce any antibody which binds to SEQ ID NO:2 regardless of specificity? or does it include any fragment which will induce an antibody to itself?.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is explained in the previous Office Action.

Applicants appear to believe the amendment of Claim 32 to "encoding a human chitinase of SEQ ID NO:2 or an immunogenic fragment thereof" limits the scope of the claimed genus to that which is clearly described by the specification. However giving the phrase "immunogenic fragment" its broadest reasonable interpretation, i.e., that it includes any fragment of SEQ ID NO:2 capable of inducing an antibody to itself, the claimed genus is still highly diverse with regards to structural and functional characteristics such that the two disclosed species cannot be considered to be representative of the genus. The claimed genus

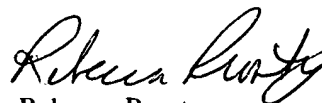
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of polynucleotides includes fragments with use only as probes and/or primers, fragments which could be used to produced peptides with use in assaying and/or purifying human chitinase, and fragments which could be used to produce proteins with chitinase activity. The two disclosed species could be considered to be representative only of those polynucleotides which encode enzymatically active fragments of the human chitinase of SEQ ID NO:2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty
Primary Examiner
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